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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 735,720	12/12/2000	Ariana L. Blum		4530

7590 02/05/2003

Blum, Ariana L.  
331 10th Street  
Jersey City, NJ 07302

EXAMINER

CARIASO, ALAN B

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 02/05/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09.735,720	12.12.2000	Ariana L. Blum		4530

7590 06.19.2002

Blum, Ariana L.  
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Jersey City, NJ 07302

EXAMINER

CARIASO, ALAN B

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DATE MAILED: 06/19/2002

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# Office Action Summary

Application No.

09/735,720

Applicant(s)

BLUM, ARIANA L.

Examiner

Alan Cariaso

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other:

**DETAILED ACTION**

***Response to Amendment***

***Drawings***

1. The corrected or substitute drawings were received on April 8, 2002. These drawings are approved.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 7-9 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claim 7, lines 1-2, the limitation "a flexible lighting element" is indefinite as being the same as or another of the "flexible lighting element" recited in preceding claim 2.
5. Claim 7, lines 2-3, the phrase "said flexible covering including an adjustable shape-retaining element" and claim 11, lines 1-2, the phrase "said adjustable shape-retaining element is incorporated in at least part of said flexible covering" are indefinite as being misdescriptive since in preceding claim 2, the first mentioned "adjustable shape-retaining element" is "coupled to said flexible lighting element". Since the lighting device is disclosed to have really one adjustable shape-retaining element per embodiment, it appears that associated claims 2 and 7 with 11 are not structurally compatible with each other.
6. Claims 8 and 11 are indefinite as depending on an indefinite claim 7.

7. Claim 9, line 2, the limitation "a rope light" is indefinite as having an unclear association with the established "tiny light bulbs" and "plastic rope" recited in preceding claim 2.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 2-4, 12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by ROBERTS (US 4,143,411).

10. ROBERTS discloses a flexible lighting element (10,14, figs.1-2; col.2, lines 25-26) which includes a plurality of tiny light bulbs (44) molded in a plastic rope (14); an adjustable shape-retaining element (80,fig.8; col.4, lines 29-38) coupled to the flexible lighting element (10) by an inherent step of coupling them; wherein the adjustable shape retaining element (80) is integrally formed or step of integrally forming (by bonding col.3, lines 60-63) with the flexible lighting element (10); the adjustable shape-retaining element is molded in the plastic rope (col.4, lines 11-14 & 29-31).

11. Claims 2-10 and 12-19 are rejected under 35 U.S.C. 102(b) as being anticipated by CHEN (US 4,812,956).

12. In regards to claims 2-6 and 12-19, CHEN discloses a flexible lighting element (fig.1; col.2, line 6) which includes a plurality of tiny light bulbs (22) molded in a plastic

rope (1); at least one wire element (31-33) coupled or inherent step of coupling to the flexible lighting element; wherein the wire element (31) is integrally formed with or step of integrally forming or being molded (col.2, lines 17-18) in the plastic rope (1); wherein the wire element (31); a translucent flexible covering (4) coupled about the flexible lighting element (col.2, lines 40-41) which inherently includes mounting and coupling the flexible lighting element (1) and wire element (31) in the translucent flexible covering (4); wherein the flexible covering is transparent (col.2, line 41);

13. In regards to claims 7 & 8, it is assumed that wire element (31) as is the flexible lighting element (1) are generally included in the transparent flexible covering (4); in regards to claim 9, wherein the flexible lighting element (1) includes or defines a rope light, assuming the rope light is the same as the "plastic rope" in claim 2; in regards to claim 10, wherein the adjustable shape-retaining element is a metal wire (31);

14. In response to applicant's argument that "adjustable shape-retaining" ability of the element identified or claimed as the metal wire, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Allowable Subject Matter***

15. Claim 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

16. Applicant's arguments with respect to claims 2-19 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. HUANG (US 6,217,194) shows metal wire elements and light bulbs (figs.3-6) integrally embedded in the flexible lamp pipe 30 being mounted or coupled to outer transparent cover layers (34,35).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (703) 308-1952. The examiner can normally be reached on M-F (9:00-5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7724 for regular communications and (703) 308-7724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

A handwritten signature in black ink, appearing to read 'Alan Cariaso', with a stylized flourish extending to the right.

Alan Cariaso  
Primary Examiner  
Art Unit 2875

AC  
June 16, 2002